



# UNITED STATES PATENT AND TRADEMARK OFFICE

*fw*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,682	01/10/2001	Bruce Beam	05052.00001	4577

22907 7590 04/21/2005

BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER
----------

VIG, NARESH

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/756,682	BEAM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Naresh Vig	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This is in reference to response received on 10 January 2004 to the office action mailed on 09 November 2004. Applicant's election of claims 1 – 8 without traverse and withdrawal of claims 9 - 26 is acknowledged. There are 8 claims, claims 1 – 8 pending for examination.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities. Claim 4 recites the limitation “.... said appraiser includes a communication device ....”. In the specification originally filed 01 January 2001, applicant discloses appraiser as a human being. Examiner reads the limitation as “.... said appraiser is provided a communication device ....”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3629

Claims 1, 4 – 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent 5,758,328.

Regarding claim, Giovannoli teaches system and method for processing requests for quotation for goods and **services** (request for getting a an appraisal service) through at least one central processing unit. Giovannoli teaches:

Receiving an electronic request for an appraisal (field of use) at a hub (means for network buyers to generate request, means for transmitting request to said central processing unit) [abstract]

Determining an appraiser (service provider) to conduct said appraisal (fulfill the request) using the determining criteria to compare information regarding potential appraisers (business choice to limited system and method for specific group of service providers (Giovannoli teaches filtering for selecting appropriate network members to receive said request for quotation based on filter conditions defined by the buyer in said request for quotation and/or by the vendor and/or by the central processing unit [abstract, Fig. 2 and disclosure associated with Fig. 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made that filtering process compares information with the search criteria and makes selections for the information that meets the search criteria).

Transmitting electronic information related to said request for appraisal (type of service, field of use) to appraiser (selected service provider, Giovannoli teaches

Art Unit: 3629

broadcasting said request for quotation to the network members selected by said filter means) [abstract].

Receiving electronic information relating to appraising work (type of service ordered by the user) from appraiser (service providing entity) (Giovannoli teaches capability to retrieve pricing and other information necessary to respond to the RFQ (data related to type of service requested by user) ) [col. 5, line 47].

Giovannoli teaches transmitting completed appraisal (response to request is emailed to the user) containing information relating to appraising work (Giovannoli teaches FIG. 8 shows one possible arrangement of RFQ data which would be e-mailed to a buyer) [col. 5, lines 49 – 50].

Regarding claim 4, Giovannoli teaches appraiser (vendor) includes a communication device that permits acceptance of request (Fig. 1, and disclosure associates with Fig. 1). It is a design choice to design the capabilities and limitations of a computer system to meet business requirements. As responded to earlier in response to claim 1, appraiser has accepted to request for appraisal to be able to complete the appraisal and transmit the appraisal to the requestor.

Regarding claims 5, Giovannoli does not teach determining criteria includes timeliness of appraisals. However, Giovannoli teaches filtering for selecting appropriate network members to receive said request for quotation based on filter conditions defined by the buyer [Fig. 2 and disclosure associated with Fig. 2]. Official notice it

Art Unit: 3629

taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to create list of search criteria to meet business requirements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include timeliness of appraisals as a search criteria to identify the reliable service providers who can complete the service in time.

Regarding claim 6, Giovannoli does not teach determining criteria includes thoroughness of appraisals. However, Giovannoli teaches filtering for selecting appropriate network members to receive said request for quotation based on filter conditions defined by the buyer [Fig. 2 and disclosure associated with Fig. 2]. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to create list of search criteria to meet business requirements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include thoroughness of appraisals as a search criteria to identify the reliable service providers whose appraisals meet underwriting requirements.

Regarding claim 8, Giovannoli does not teach creating performance statistics based on completed appraisals. However, Giovannoli teaches filtering based on filter conditions defined by a buyer. As responded to earlier in response to claim 6, it would

Art Unit: 3629

have been obvious to one of ordinary skill in the art at the time the invention was made that Giovannoli creates performance statistics based on some criteria to be able to make selection based on search criteria as defined by the buyer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovanalli and create performance statistics based on some criteria to be able to make selection based on search criteria as defined by the buyer.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent 5,758,328 in view of as article XML By Example Is Here by PeopleSoft hereinafter known as PeopleSoft.

Regarding claim 2, Giovannoli does not teach to contain XML information. However, PineappleSoft discloses the use of XML in Business to Business and Business to Consumer computer-implement online commerce. PineappleSoft discloses that XML makes it possible for computers at two companies to dialog and automatically exchange information. They can conduct business, at least the costly and slow administrative part of it automatically [page 2].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli as taught by PineappleSoft to XML

makes it possible for computers at two companies to dialog and automatically exchange information.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli US Patent 5,758,328 in view of Jost et al. US Patent 5,361,201 hereinafter known as Jost.

Regarding claim 7, Giovannoli does not teach comparing completed appraisals against previous appraisals. However, Jost teaches comparing completed appraisals against previous appraisals (compares the value range with an appraisal) [Jost, col. 5, lines 35 – 35].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giovannoli as taught by Jost and compare the appraisal against previous appraisals to minimize underwriting loss due to fraudulent appraisals.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Shavit et al. US Patent 4,799,156

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

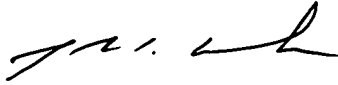
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig  
Patent Examiner  
April 15, 2005

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3300